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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,821	07/06/2000	Terrell Neils Andersen	1060A	5412

7590

07/08/2002

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EXAMINER

PHASGE, ARUN S

ART UNIT

PAPER NUMBER

1741

DATE MAILED: 07/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/610,821

Applicant(s)

ANDERSEN ET AL.

Examiner

Arun S. Phasge

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1741

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 17-25 are rejected under 35 U.S.C. 102(b and/or 3) as being anticipated by Fleischer, U.S. Patent 5,580,681.

The Fleischer patent discloses the claimed electrolytic magnesium dioxide (see column 6). It has been well settled that the intended use of a composition is not patentably significant. *In re Heck* 114 USPQ 161 (CCPA 1957). Additionally, it has been

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held that the burden is on applicants to show product differences in product comparisons.

Ex parte Gray 10 USPQ 2d 1922, 1925 (BPAI 1989).

Claims 17-25 are rejected under 35 U.S.C. 102(b and/or 3) as being anticipated by Mieczkowska et al. (Mieczkowska), U.S. Patent 5,516,604.

The Mieczkowska patent discloses the claimed electrolytic magnesium dioxide (see column 2). It has been well settled that the intended use of a composition is not patentably significant. *In re Heck* 114 USPQ 161 (CCPA 1957). Additionally, it has been held that the burden is on applicants to show product differences in product comparisons. *Ex parte Gray* 10 USPQ 2d 1922, 1925 (BPAI 1989).

Claims 17-25 are rejected under 35 U.S.C. 102(b and/or 3) as being anticipated by Jacus et al. (Jacus), U.S. Patent 5,607,796.

The Jacus patent discloses the claimed electrolytic magnesium dioxide (see column 9). It has been well settled that the intended use of a composition is not patentably significant. *In re Heck* 114 USPQ 161 (CCPA 1957). Additionally, it has been held that the burden is on applicants to show product differences in product comparisons. *Ex parte Gray* 10 USPQ 2d 1922, 1925 (BPAI 1989).

Claims 17-25 are rejected under 35 U.S.C. 102(b and/or 3) as being anticipated by Fleischer et al. (Fleischer), U.S. Patent 5,731,105.

The Fleischer patent discloses the claimed electrolytic magnesium dioxide (see column 7-8). It has been well settled that the intended use of a composition is not

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patentably significant. *In re Heck* 114 USPQ 161 (CCPA 1957). Additionally, it has been held that the burden is on applicants to show product differences in product comparisons. *Ex parte Gray* 10 USPQ 2d 1922, 1925 (BPAI 1989).

Claims 17-25 are rejected under 35 U.S.C. 102(b and/or 3) as being anticipated by Sumida et al. (Sumida), U.S. Patent 5,866,278.

The Sumida patent discloses the claimed electrolytic magnesium dioxide (see abstract). It has been well settled that the intended use of a composition is not patentably significant. *In re Heck* 114 USPQ 161 (CCPA 1957). Additionally, it has been held that the burden is on applicants to show product differences in product comparisons. *Ex parte Gray* 10 USPQ 2d 1922, 1925 (BPAI 1989).

Claims 17-25 are rejected under 35 U.S.C. 102(b and/or 3) as being anticipated by Davis et al. (Davis), U.S. Patent 6,143,446.

The Davis patent discloses the claimed electrolytic magnesium dioxide (see column 4). It has been well settled that the intended use of a composition is not patentably significant. *In re Heck* 114 USPQ 161 (CCPA 1957). Additionally, it has been held that the burden is on applicants to show product differences in product comparisons. *Ex parte Gray* 10 USPQ 2d 1922, 1925 (BPAI 1989).

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

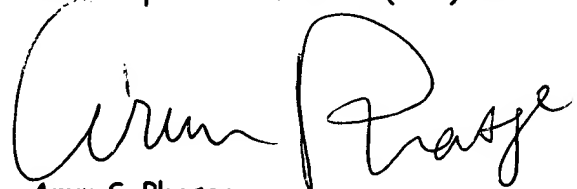
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun S. Phasge whose telephone number is (703) 308-2528. The examiner can normally be reached on MONDAY-THURSDAY, 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X Nguyen can be reached on (703) 308-3322. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Arun S. Phasge
Primary Examiner
Art Unit 1741

asp
July 3, 2002